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10/619,044	07/14/2003	John M. Meyer JR.	7779	6067

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EXAMINER

SAYALA, CHHAYA D

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPAdmin@reinhardtllaw.com

Office Action Summary	Application No. 10/619,044	Applicant(s) MEYER ET AL.	
	Examiner C. SAYALA	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-7 and 10-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-7, 10-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1, 4-7, 10-37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's amended claims recite "said hides or skins being free of animal blood". The specification as originally filed has been carefully reviewed (with Microsoft Word search) and there is no support found for such a limitation. Upon applicant pointing out where such a description can be found, the rejection will be withdrawn.

Claim Rejections - 35 USC § 102/ Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 32, 34, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hanson (US Patent 6676981).

The above reference teaches crustacean baits that are made from scented cow hide at col. 3, lines 52-56, as Sea LureTM and Sea HideTM. The claims recite "crustacean bait" and such terminology is considered "use" terminology. The rejection is being made under both statutes because "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is

eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). As for claims 34 and 36, which are based on the independent claims that recite "edible" bait, since the references also teach a bait from rind/hide, then it must also be edible, even though the reference does not explicitly state that this is the case.

Claim Rejections - 35 USC § 103

3. Claims 1, 4-7, 10-22, 30-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson (US Patent 6676981) and the prior art disclosure in the instant specification at page 1, paragraph [0003] and page 2, paragraph [0005] in view of Weaver et al. (US Patent 3920388) and Maue (US Patent 4762522) and Thiele (US Patent 4224028) taken with Pfeiderer et al. (US Patent 4484924), Hague et al. (US Patent 6827041) and Talty et al. (US Patent 3408918).

Hanson teaches that two scented cowhide products as crustacean baits, were already available in the market even as far back as January 2002. The specification also discloses that cowhide was used in Florida as crustacean bait. The specification also discloses at page 1, paragraph [0003] that traps or pots baited with crustacean bait were already in use at the time the invention was made. The Hanson patent does not teach the method of producing the final product or the method of making these

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marketed products. Hanson teaches that the hide is initially laden with soil, dirt, manure, blood, etc. The remaining steps are not taught.

Weaver et al. teach that it is well known in the art that freshly removed animal hides deteriorate rapidly because of enzyme and microbial action. See col. 1, lines 19-26. The patent to Maue teaches that “When a hide is removed from the carcass, the first concern is to preserve or cure that hide so that it is protected...”.

Artificial lures use rawhides, hides or skins, as shown by prior art and the process steps of liming, deliming, rinsing, bleaching, curing etc. such hides or skins are also known in the art, and the motivation to use such processes to prepare such artificial bait is to primarily clean them and to convert them to be stable, to prevent and/or retard putrefaction of skins, hides of freshly slaughtered animals. See Thiele. See col. 2, in Thiele, and though this patent is drawn to the tanning industry, the artisan would have recognized that in preparation of rawhide for a bait, the same problems exist because decay, putrefaction would have been inherent disadvantages to both utilities.

These three patents are used here to show that hides when removed from an animal's carcass, irrespective of their end use, will undergo deterioration from enzyme and microbial action and are to be treated to overcome this. They do not teach the steps that condition these hides for use as claimed.

Pfleiderer et al. teach washing hides/skins for the removal of dirt, soaking in hydrated lime or alkalies to a pH of from 7-11, deliming with acids such as citric acid and finally, curing with NaCl. See col. 6, e.g. 1; col. 5, lines 16; col. 2, line 40, which

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teaches that mixing/washing can be done in a drum or in a mixer. Note too that in the soak liquor containing alkali that brings the pH value to between 8 and 10 (see line 63), "wetting agents" (detergents) are used. Thus all the steps were known in the art at the time the invention was made.

To substantiate this fact, see Hague et al. who teach that skin is washed with alkali, washed with salts such as ammonium chloride, and then bleached. See col. 5, lines 3-10, which show the fat and oil is removed by agitating with sodium salts. The degrease materials can also be a detergent, and the skin is bleached so that the skin is low in oil, and is soft. See example 1. At col. 4, the patentees teach that the skins are agitated in alkali in drums that have agitators in them typically in the forms of ribs that lift the skins and drop them. The skins are then washed and alkali is removed with ammonium chloride. The skins are rinsed at this stage for 0.5 to 3 hours. The first step of alkali treatment and washing is done at 10-40⁰C. The patent states "The two steps for removing the alkali can vary in time and depend on the concentration and quantity of the chemicals, the temperature of the components inside the drum and the speed that the drum turns. The worker or operator can adjust the times as needed." Although the patent does not teach the temperature used for deliming, to follow the guidance provided by the above patent would have been obvious to one of ordinary skill in the art, and therefore to use the same temperature range and adjust the times as needed would have been obvious. Talty et al., also drawn to processing of hides, show liming for a period of less than 4 days for periods of 3-12 hours or less, which reads on the limitation claimed instantly. The hide pieces are then neutralized with acids such as citric acid

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(see col. 3). The delimed, washed hides are then further processed to final products. Note that the above references do not expressly state that blood was removed, however, one of ordinary skill in the art in considering the Hanson reference, would have removed blood because of the microbial decontamination as taught by Hanson, and the use of reactants/processes such as alkali washing, deliming, bleaching, detergents, etc. would have achieved this.

These references add to the disclosure of Pfleiderer et al. that processing steps from skin or hide to remove fat, flesh, hair and to bleach the skin or hide so as to form the final product were similar. Note that although only a few of the limitations pertaining to amounts, and time and temperature of wash/rinse water are disclosed as claimed, such determinations would depend primarily on the type and volume/weight of skin and hide, and end product use. To add steps such as checking pH of the acid solution, draining washing solutions, adding more water or alkali or acid if more is necessary or to adjust such levels to below a particular required value, are steps that would have been routine and obvious to the skilled worker, barring any evidence to the contrary. To use temperatures of rinse liquids above 100° C also would also have been obvious for the logical scientific fact of removing fat and grease with warm water and adding to the degrease effect that one of ordinary skill would have associated with the degrease techniques used above with respect to the chemicals disclosed.

As for claims 34 and 36, which are based on the independent claims that recite “edible” bait, since the references also teaches a bait from rind/hide, then it must also be edible, even though the reference may not explicitly state that this is the case.

4. Claims 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson (US Patent 6676981) and the prior art disclosure in the instant specification at page 1, paragraph [0003] and page 2, paragraph [0005] in view of Weaver et al. (US Patent 3920388) and Maue (US Patent 4762522) and Thiele (US Patent 4224028) taken with Pfeiderer et al. (US Patent 4484924), Hague et al. (US Patent 6827041) and Talty et al. (US Patent 3408918) and further in view of Williams Jr. (US Patent 3964203) and Carr (US Patent 4463018).

Using skins as fishing lures were known in the art at the time the invention was made. See for instance Williams, Jr, who teaches the use of pork rind in prior art and chamois in the reference invention, the latter being treated with cod-fish oil. The chamois is cut into strips and the strips have an attachment hole at one end for a fish hook. See the claims. Carr also describes using artificial bait incorporated with an attractant such as fish-oil and that can be used in traps or pots (col. 4, lines 40-41). To cut the hide obtained from the combined references of Pfeiderer et al., Hague et al. and Talty et al. so as to form strips with a hole for a hook and to incorporate an attractant into the bait/lure such as fish oil, a known fish attractant as shown by Williams, would have been obvious to the practitioner at the time the invention was made based on the obvious benefits.

As for packaging the artificial lures, this limitation has been in use in prior art as shown by Carr (see col. 6). To choose plastic containers and to pack the attractant with

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the bait would have been an obvious modification over applying the oil to the rawhide and then packing it. Disclosure of fish oil renders obvious all the specific oils claimed.

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson (US Patent 6676981) and the prior art disclosure in the instant specification at page 1, paragraph [0003] and page 2, paragraph [0005] in view of Weaver et al. (US Patent 3920388) and Maue (US Patent 4762522) and Thiele (US Patent 4224028) taken with Pfleiderer et al. (US Patent 4484924), Hague et al. (US Patent 6827041) and Talty et al. (US Patent 3408918) and further in view of Gould (US Patent 3670534) and Holdsworth (US Patent 3913360).

The primary references are as discussed above. Although Hague et al. teach that the skins are agitated in alkali in drums that have agitators in them typically in the forms of ribs that lift the skins and drop them and .Pfleiderer et al. teach a mixer for processing hides and rinds, they do not disclose any particular device. Mixing devices with respect to processing hides are disclosed by Holdsworth and Gould. To adjust the blades in a manner that would provide the necessary mixing, given the prior art devices and their blades, would have been within the ambit of ordinary skill. When the primary reference teaches that “a mixer” was used, it is prima facie obvious to select a mixer/device from a reference that pertains to the same endeavor: processing hides.

Response to Arguments

Applicant's arguments filed 5/15/2008 have been fully considered but they are not persuasive.

The rejection under 35 USC 112, first paragraph has been maintained for lack of written description. The specification does not provide sufficient evidence to persons skilled in the art that the specification as filed contemplated the derivative now claimed. See MPEP 2163. The standard for evaluating new matter in the claims is not whether the subject matter would be obvious to one skilled in the art from the spec as originally filed. An objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Under *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. The test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

Applicant states that "soil and dirty" would be recognized by one skilled in the art that it includes blood. If this were the case, then the amendment to the claim, when

there is no express inclusion of "blood" in the description, is certainly unnecessary too and would have been obvious. The US Patent to Weaver et al. lists dirt, soil and blood separately at col. 2, lines 21-23 and does not support applicant's position.

The traversals on page 12 criticizing Yearley, Carr and Coody are discussed below to the extent it applies to the rejection now made. Carr has been criticized as being drawn to an artificial bait made from a gel material. To the extent used in the rejection, Carr's disclosure for showing the use of the bait in traps or pots with an attractant oil, a fish oil, would have been beneficial for any bait, regardless of whether it is made from gel or hide. Such a benefit to attract fish with oil would have been beneficial to the hide product of the Pfeiderer, Hague and Talty. Applicant's argument therefore, is not so convincing to cause the withdrawal of these rejections so that the case can be allowed. In the same vein, Williams has been relied on for one reason only: the use of the attractant on the bait therein and a hole provided in the strip for the hook. Applicant's position is therefore, not understood. Is applicant stating that when the same attractant is used on hide, the fish are indifferent to the attractant? If this is the case, then such a statement on record will be further considered. The Office position is that when the attractant shown by Williams is applied on the hide of the primary references, or the hide is provided with a hole for the hook, one of ordinary skill would reasonably expect that it would be just as beneficial in attracting the same fish.

Pfeiderer et al. teaches an enzyme or sulfide in the presence of alkali, and not as applicant has characterized this reference. It should be noted that none of these additives are excluded by the claims. As such, the temperature applicant refers to

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would not affect the process when sulfides are present. See claim 4. Applicant also states that the utility of the patent is different. This patent is being relied on for its teaching that pertains to cleaning of the hides and skins, which would be important whether the skin or hide is used for shoes or baits or rawhide chew for dogs. See for instance Spanier et al. that teaches cleaning cowhides, liming, deliming and cutting the hide into strips. See col. 10. At col. 9, line 8+, patentees teach that:

The liming step, when complete, is followed by deliming. The hide is washed to remove soluble lime and hair particles. At this point, the stock is at a pH of 12.5. The most widely used deliming salt is ammonium sulfate, which lowers the pH to 8 to 9.

Puering is the treatment of delimed or partially delimed skins. Bating is a similar process, generally `synthetic` bates are used; these contain enzymes, obtained from the pancreas of animals, to which neutral deliming salts are added. Puering and bating assist in the removal of short hairs, lime soaps, and cementing substances in the skin, and in depleting and deliming. As a result of this process, the stretch and pliability of the leather is increased.

Deliming and using enzymes provide similar functions. The instant invention uses deliming with chemicals other than enzymes. Such a concept is known in prior art and to exclude enzymes would have been obvious in view of Spanier. In any event, the claims do not exclude enzymes.

The same argument holds good for the remaining references that applicant states do not teach *all* the limitations claimed herein and are non-analogous in nature. Such references have been used for specific teachings that one would have considered as beneficial and pertinent in the preparation of hides or skin, whether they are used as casing, shoes or bait. Furthermore applicant has unduly limited his view of all that each reference would have fairly suggested to a person having ordinary skill in this art. Under 35 USC 103, a reference must be considered not only for what it expressly

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teaches, but also for what it fairly suggests. In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979).

Applicant has stated at pages 14-15 applicant has remarked that the references are unrelated in utility, that there is no motivation to combine them, and that the examiner has used improper hindsight. Each of the references of Pfleiderer and Hague et al. are related to cleaning skins, therefore these two references point to similar processes and chemicals in cleaning hides and therefore, are combinable and the skilled worker who is looking to find processes to clean and prepare hides would have known to combine them since their teachings reinforce each other. Talty is used only for its showing of the time required for processing of hides and therefore is important and useful for such disclosure. The motivation to combine such references would have been obvious since the teachings present a comprehensive process with all the innumerable limitations of the instant claims, which would produce a method of preparing hides as claimed for bait material. The references show that these limitations were already being practiced in the prior art and all applicant appears to have done is combined them. As stated in the specification, the use of raw hides were known as crustacean baits in traps and pots. And as shown by these references, it was known that these hides and skins have to be decontaminated because of the microbial action that deteriorates them. The steps needed for such decontamination are generally, washing, liming, deliming, curing and bleaching. These references show them all, not just for lures or baits but anywhere hides are used because wherever hides are used, the problem is the same and such would be obvious to the skilled artisan.

The steps of liming, deliming, washing after every step, bleaching, curing, are all shown by prior art. In addition, the Hague et al. patent states:

“The two steps for removing the alkali can vary in time and depend on the concentration and quantity of the chemicals, the temperature of the components inside the drum and the speed that the drum turns. The worker or operator can adjust the times as needed.”

The same statement renders obvious the treatment step with alkali also.

The above rejection states: To use temperatures of rinse liquids above 100° C also would also have been obvious for the logical scientific fact of removing fat and grease with warm water and adding to the degrease effect that one of ordinary skill would have associated with the degrease techniques used above with respect to the chemicals disclosed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Spanier et al. (US Patent 5047231) teach cleaning cowhides, liming, deliming and cutting the hide into strips. See col. 10. At col. 9, line 8+, patentees teach that:

The liming step, when complete, is followed by deliming. The hide is washed to remove soluble lime and hair particles. At this point, the stock is at a pH of 12.5. The most widely used deliming salt is ammonium sulfate, which lowers the pH to 8 to 9.

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Puering is the treatment of delimed or partially delimed skins. Bating is a similar process, generally `synthetic` bates are used; these contain enzymes, obtained from the pancreas of animals, to which neutral deliming salts are added. Puering and bating assist in the removal of short hairs, lime soaps, and cementing substances in the skin, and in depleting and deliming. As a result of this process, the stretch and pliability of the leather is increased.

Deliming and using enzymes provide similar functions. The instant invention uses deliming with chemicals other than enzymes. Such a concept is known in prior art and to exclude enzymes would have been obvious in view of Spanier. Spanier has not been applied in view of the preponderance of patents in the art that teach cleaning hides and preparing them so that they do not contribute to contamination of the end product, i.e. the same problem being addressed here.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Sayala, whose telephone number is (571) 272-1405. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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/C. SAYALA/

Primary Examiner, Art Unit 1794